

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Federico T. Marques	Group Art Unit: 1744
Serial No.: 10/001,778	Examiner: Thornton, KM
Filed: October 23, 2001	Atty. Dkt. No.: 20097.0002.NPUS00 (previously 97007/01C1)
Title: AN AIR FILTERING APPARATUS AND METHODS FOR USING SAME	Confirmation No: 3051

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**PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW THE HOLDING OF
ABANDONMENT**

Applicant is filing the present petition under 37 C.F.R. § 1.181 to request that the holding of abandonment of U.S. Pat. App. No. 10/001,778 be withdrawn because the reply to the Office Action dated December 8, 2004 should be found to have been sufficient. Federico Marques is the inventor of the application embodied in U.S. Pat. App. No. 10/001,778. An affidavit signed by Mr. Marques is attached as Exhibit A.

According to PAIR, a Notice of Abandonment was mailed regarding U.S. Pat. App. No. 10/001,778 on February 16, 2005 stating that the application is abandoned in view of Applicant's failure to timely file a proper reply to the Office letters mailed on August 6, 2004 and March 23, 2004. The March 23, 2004 letter is a Non-Final Office Action and the August 6, 2004 letter is a Notice of Non-Compliant Amendment. The client's former attorney, Mr. Robert Strozier, filed responses to the Office Action mailed March 23, 2004 on July 23, 2004 and December 8, 2004 that were deemed non-compliant.

The July 23, 2004 response was held non-compliant because new paragraphs were underlined (a paragraph to be added regarding related applications was underlined), a complete listing of all of the claims was not present (Claims 1-8 and 10-20 were not present and identified as canceled), "presently added" was used as a status identifier instead of "presently presented", and Claim 9 was included but had been previously cancelled in an amendment filed October 23, 2001. August 6, 2004 Notice of Non-compliant Amendment. The December 8, 2004 response remedied those issues except that the status identifier "previously added" was used instead of "previously presented." Applicant's counsel explained that Claim 9 was inadvertently canceled in the October 23, 2003 Preliminary Amendment. However, the date of the Preliminary Amendment should have been listed by Applicant's counsel as October 23, 2001. The PTO sent a Notice on December 21, 2004 that December 8, 2004 response was not compliant because the status identifier "previously added" was used instead of "previously presented."

Applicant stated that Mr. Strozier did not notify him regarding the office action, that the responses were non-compliant, or of the Notice of Abandonment. Applicant stated that he learned that the patent application was abandoned on August 5, 2010 when he met with Mr. Strozier.

Applicant and current counsel have been attempting to obtain the physical prosecution file from former counsel but to date have only received electronic files of documents drafted by former counsel. On September 16, 2010, Mr. Guillermo Munoz, an employee of Novak Druce + Quigg LLP whose position is that of Patent Agent/Docketing, spoke with Mr. Strozier regarding obtaining the application file for U.S. Pat. App. No. 10/001,778 as well as the trademark application file for U.S. Ser. No. 77308224. On September 21, 2010, following another conversation between Mr. Munoz and Mr. Strozier, Mr. Strozier sent Mr. Munoz, by email, 1) twenty-seven electronic files in Word Perfect and one electronic file in Word at 4:20 p.m. Central and 2) one electronic file in Visio at 4:22 p.m. Central for U.S. Pat. App. No. 10/001,778. The electronic files did not include documents received from the United States Patent and Trademark Office. An affidavit signed by Mr. Munoz is attached as Exhibit B. As such, it is not known whether Mr. Strozier received the Notice of Abandonment.

The Transaction History on PAIR lists that a “Miscellaneous Communication to Applicant - No Action Count” was mailed to Applicant’s counsel on November 4, 2004 (and referred to in the December 8, 2004 response) but the Image File Wrapper does not include a document for that date. In addition, the PAIR Image File Wrapper lists portions of the July 23, 2004 reply as an Informal or Non-responsive Amendment and Claim-Amendment Not Entered but lists portions of the December 8, 2004 reply as Miscellaneous Incoming Letter and Claims.

Applicant files the present petition to withdraw the holding of abandonment based upon the United States Patent and Trademark Office’s publication of a Notice in the July 5, 2005 Official Gazette that stated, effective immediately, the PTO would accept certain non-compliant amendments. The Notice stated “[u]pon review, the Office has determined that some of the requirements of 37 C.F.R. § 1.121 are not essential and that waiver of certain provisions of 37 C.F.R. § 1.121 will still allow an examiner to clearly understand exactly what amendments have been made in an Image file Wrapper application.” Notice in the July 5, 2005 Official Gazette. The Notice also stated

“[t]he Office wants to reduce the burden on both the applicants and the Office and avoid delays in processing that result from holding an amendment non-compliant when the only non-compliance is the use of certain status identifiers that are not provided in 37 C.F.R. 1.121(c) and which are determined to be clear and accurate by the Office. Thereby the Office hereby waives the provision in 37 C.F.R. 1.121(c) that the status of the claims must be indicated by one of the status identifiers listed in 37 C.F.R. 1.121(c) to the extent permitted in this Notice.”

Id. Explicitly included in the table in the Notice was that the PTO would not consider an amendment non-compliant for using “previously added” instead of “previously presented.” The present application should not be considered abandoned based on the Notice in the July 5, 2005 Official Gazette.

It appears that Applicant’s former counsel did not respond to the December 21, 2010 Notice of Non-compliant Amendment nor did former counsel petition the Office regarding following the July 2005 Notice in the Official Gazette. Applicant states that he did not receive a Notice of Abandonment from his former counsel and that he was not aware that a Notice of Abandonment had been mailed in the present application until August 5, 2010.

Applicant is aware that the PTO may consider a Request to Withdraw a Holding of Abandonment under 37 C.F.R. § 1.181(f) untimely if filed more than two months following the mailing of the Notice of Abandonment. 37 C.F.R. § 1.181(f) states that “[a]ny petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.” 65 FR 54604, 54646 states that: “[t]he Office has long considered the two-month period in § 1.181(f) to be the benchmark for determining the timeliness of petitions. See Changes to Patent Practice and Procedure, 62 FR at 53161, 1203 Off. Gaz. Pat. Office at 88 (the Office considers the two-month period in § 1.181(f) to be the appropriate period by which the timeliness of a petition should be determined).”

Therefore, Applicant is filing herewith a petition under 37 C.F.R. § 1.183 to waive 37 C.F.R. § 1.181(f). 37 C.F.R. § 1.183 allows for the Director to suspend any requirement of the regulations in an extraordinary situation when justice requires. This is an extraordinary situation where justice requires that the rule in 37 C.F.R. § 1.181(f), that a petition may be dismissed as untimely if not filed within two months of the mailing date of the action or notice from which relief is requested, be suspended or waived by the Director.

The extraordinary situation is the PTO’s waiver in the July 5, 2005 Official Gazette of the provision of 37 C.F.R. § 1.121(c) that required “previously presented” included that a response would not be held non-compliant for use of “previously added” instead of “previously presented.” Notice in the July 5, 2005 Official Gazette. Had the response by Applicant’s former counsel been due and filed a mere seven months later, the response would not have been considered non-compliant and the application would not have received a Notice of Abandonment. This fact, coupled with the failure of former counsel to seasonably take advantage of this provision, and seasonably inform the client of the Office Action, Notices of Non-compliant Reply, or of the Notice of Abandonment indicate that justice requires that the requires that 37 C.F.R. § 1.181(f) be waived and the holding of abandonment withdrawn.

In addition, MPEP 711.03(c)(I)(C) states that “[r]ather than dismiss an untimely petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181(f), the Office may require a

terminal disclaimer as a condition of granting an untimely petition to withdraw the holding of abandonment.” As the present application was filed on or after May 29, 2000, a terminal disclaimer would not be required as any patent term adjustment is automatically reduced under the provisions of 37 C.F.R. § 1.704. MPEP 711.03(c)(I)(C)(3). The United States Patent and Trademark Office issued a statement stating that “if a petition to withdraw a holding of abandonment is not filed within two months from the mailing date of the notice of abandonment, any patent term adjustment will be reduced under the provisions of 37 C.F.R. 1.704(c)(4).” Untimely Filing of Petitions under 37 C.F.R. 1.181(a) to Withdraw Holdings of Abandonment, available at <http://www.uspto.gov/web/offices/pac/dapp/opla/precognotice/wdabnmt.pdf>. Applicant requests that the present petition not be dismissed for being untimely and that the petition be granted with a reduction of any patent term adjustment according to the provisions of 37 C.F.R. § 1.704.

Applicant should not have to suffer the abandonment of his patent application due to a word choice by former counsel that later would not have been sufficient to hold the reply non-compliant. Applicant has not intentionally delayed the filing of a petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181(f). Applicant respectfully requests that the holding of abandonment of U.S. Pat. App. No. 10/001,778 be withdrawn.

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application. The undersigned representative authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Attorney Docket No.: 20097.0002.NPUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner may directly contact the undersigned by phone to further the discussion.

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Respectfully submitted,

/Melissa D. Schwaller/

Melissa D. Schwaller
Reg. No. 46,089

Exhibit A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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AFFIDAVIT OF FEDERICO MARQUES

STATE OF TEXAS

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COUNTY OF HARRIS

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BEFORE ME, the undersigned authority on this day personally appeared October 1, 2010, who, being first duly sworn, stated as follows:

1. My name is Federico T. Marques. I am over 18 years of age, of sound mind, and am fully competent to make this Affidavit. I have personal knowledge of all facts stated herein, and they are true and correct.
2. I am an inventor of the application embodied in U.S. Pat. App. No. 10/001,778.
3. I intended that my attorney file compliant responses to any office actions on or before the deadline for doing so. I did not receive notice of the Office Action mailed by the United States Patent and Trademark Office on March 23, 2004 ("March 23, 2004 Office

Action"). A response to the March 23, 2004 Office Action deemed to be compliant was not filed before the deadline for doing so. My attorney at the time, Robert Strozier, filed responses to the March 23, 2004 Office Action on July 23, 2004 and December 8, 2004 that were deemed non-compliant. I did not receive notice from Mr. Strozier that the responses were non-compliant nor that the above-referenced patent application had become abandoned. I was not aware that the above-referenced patent application had become abandoned until August 5, 2010 when I met with Mr. Strozier and he told me that the above-referenced patent application was abandoned.

4. The entire delay in filing the required compliant response from the due date for filing the compliant response until the filing of this affidavit was unintentional. I am therefore submitting the accompanying petition in accordance with 37 C.F.R. § 1.181 to petition to withdraw the holding of abandonment along with a petition under 37 C.F.R. § 1.183 to request suspension of the rules regarding the requirement of 37 C.F.R. § 1.181(f) and the fee set forth in 37 C.F.R. §1.17(f).
5. The United States Patent and Trademark Office mailed a Notice of Abandonment in U.S. Pat. App. No. 10/001,778 because a response to the Office Action mailed by the United States Patent and Trademark Office on March 23, 2004 that was deemed compliant was not filed before the deadline for doing so.
6. I discovered that the above-referenced patent application was abandoned on August 5, 2010. Subsequently, I contacted Mr. Strozier on September 3, 2010 to obtain a copy of the application file. On September 14, 2010, Mr. Strozier provided me with files for other matters but not for U.S. Pat. App. No. 10/001,778 and the trademark application file

for U.S. Ser. No. 77308224. I verbally authorized my counsel Novak Druce + Quigg LLP on September 14, 2010 to contact Mr. Strozier in an effort to obtain the file U.S. Pat. App. No. 10/001,778. Consequently, I authorized my counsel, Novak Druce + Quigg LLP to submit this affidavit and the accompanying petitions with the necessary fees.

FURTHER AFFIANT SAYETH NOT.



SUBSCRIBED and SWORN TO BEFORE ME, the undersigned authority, on this the

Oct. 5, 2010.





NOTARY PUBLIC in and for the
STATE OF TEXAS

Exhibit B

In re Application of: Federico Marques	Group Art Unit: 1744
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Title: AN AIR FILTERING APPARATUS AND METHODS FOR USING SAME	Confirmation No: 3051

AFFIDAVIT OF GUILLERMO MUNOZ

STATE OF TEXAS §
COUNTY OF HARRIS §

BEFORE ME, the undersigned authority on this day personally appeared on October 4, 2010, who, being first duly sworn, stated as follows:

1. My name is Guillermo Munoz. I am over 18 years of age, of sound mind, and am fully competent to make this Affidavit. I have personal knowledge of all facts stated herein, and they are true and correct.
2. My position at Novak Druce + Quigg LLP is that of Patent Agent/Docketing.

3. On September 16, 2010, I spoke with Mr. Robert Strozier regarding obtaining the application file for U.S. Pat. App. No. 10/001,778 as well as the trademark application file for U.S. Ser. No. 77308224.
4. During my September 16, 2010 phone conversation with Mr. Robert Strozier, I informed Mr. Robert Strozier that the files for U.S. Pat. App. No. 10/001,778 and U.S. Trademark App. No. 77308224 were not included in the files transferred from his office. Mr. Robert Strozier stated that he would search his office for the file for U.S. Pat. App. No. 10/001,778, but indicated that he did not have a file for U.S. Ser. No. U.S. Trademark App. No. 77308224. Mr. Robert Strozier stated that the U.S. Trademark App. No. 77308224 was not in his docketing system, and that the client was prone to filing their own applications.
5. On September 21, 2010, I spoke with Mr. Robert Strozier regarding our September 16, 2010 conversation. Mr. Robert Strozier stated that he was not able to locate the physical file for U.S. Pat. App. No. 10/001,778, but would continue to search. Furthermore, Mr. Robert Strozier informed me that although he did not have the physical file, he did have the electronic file for U.S. Pat. App. No. 10/001,778, and would send it to me via e-mail. I further questioned Mr. Robert Strozier about U.S. Trademark App. No. 77308224, but he maintained that he did not have a physical file for this trademark application.
6. On September 21, 2010, Mr. Robert Strozier sent me, by email, 1) twenty-seven electronic files in Word Perfect and one electronic file in Word at 4:20 p.m. Central and

2) one electronic file in Visio at 4:22 p.m. Central for U.S. Pat. App. No. 10/001,778.

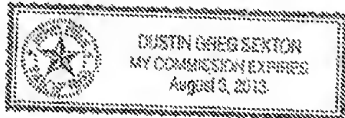
The electronic files did not include documents received from the United States Patent and Trademark Office.

FURTHER AFFIANT SAYETH NOT.

Dustin G. Sexton

SUBSCRIBED and SWORN TO BEFORE ME, the undersigned authority, on this the

Oct. 4th, 2010.



[Signature]
NOTARY PUBLIC in and for the
STATE OF TEXAS